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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,425	09/16/2005	Gerhard Lammel	10191/4133	4531
26646	7590	06/09/2008	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				GOUDREAU, GEORGE A
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
06/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/529,425	LAMMEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	George A. Goudreau	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 March 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10 and 12-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 10 and 12-17 is/are allowed.

6) Claim(s) 18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

Art Unit: 1792

1. Claims 10, 12-17 are allowed.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by the reference as applied in paragraph 4 of the previous office action.

In regards to applicant's process limitations in their product claims, the examiner cites the case law listed below of interest to the applicant.

Furthermore, it is obvious to one skilled in the art that the configuration of the substrate worked upon by the apparatus claimed in this invention is not patentable in view of In re Young (25 U.S.P.Q. 69, 71 (CCPA 1935)) and In re Rishoi (94 U.S.P.Q. 71,73 (CCPA 1952)). The Court of Customs and Patent Appeals stated in In re Young that inclusion of material worked upon by a machine as element in claim may not lend patentability since claim is not otherwise allowable. Similarly, the Court of Customs and Patent Appeals stated in In re Rishoi that there is no patentable combination between a device and the material upon which it works.

Thus, all of applicant's claimed limitations are fully met in this regard.

4. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by the reference as applied in paragraph 5 of the previous office action.

In regards to applicant's process limitations in their product claims, the examiner cites the case law listed below of interest to the applicant.

Furthermore, it is obvious to one skilled in the art that the configuration of the substrate worked upon by the apparatus claimed in this invention is not patentable in view of In re Young (25 U.S.P.Q. 69, 71 (CCPA 1935)) and In re Rishoi (94 U.S.P.Q. 71,73 (CCPA 1952)). The Court of Customs and Patent Appeals stated in In re Young that inclusion of material worked upon by a machine as element in claim may not lend patentability since claim is not otherwise allowable. Similarly, the Court of Customs and

Patent Appeals stated in In re Rishoi that there is no patentable combination between a device and the material upon which it works.

Thus, all of applicant's claimed limitations are fully met in this regard.

5. Applicant's arguments filed 3-14-2008' have been fully considered but they are not persuasive.

Applicant argues the following points regarding the examiner's rejection of their claimed subject matter.

-Newly amended claim 18 is now allowable over the prior art of record for the same reasons that newly amended claim 10 is allowable over the prior art of record.

The examiner must disagree.

-Claim 10 is a method claim for producing a micromechanical component which recites a specific sequence of process steps which must be conduct in order for the component to be formed. Claim 18 is a product claim which recites that is formed using a specific sequence of steps. Unlike claim 10, all of the limitations of claim 18 can be fully met using a process which employs a different sequence of process steps for forming the component than those which are claimed by the applicant in claim 10 if the final component which is formed in the prior art is the same as that which is formed using the specific processes which are recited in claim 18. Since the prior art which is used to reject claim 18 is capable of producing a component with the same features of those of the finished component which is produced using the process which is recited in

claim 18, all of applicant's claimed limitations are fully met in this regard.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication should be directed to examiner George A. Goudreau at telephone number 571-272-1434.

/George A. Goudreau/  
Primary Examiner, Art Unit 1792